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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/658,079 | 09/11/2000 | Brian M. Romansky | E-996 | 4596 |

919 7590 10/28/2004

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| EXAMINER |
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ELISCA, PIERRE E

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,079

Applicant(s)

ROMANSKY, BRIAN M. 

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has made an updated search and found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the non-final Office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 1-41 remain pending in the application.

Claim Objections

2. Claims 6-10, 20, 29, 35 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, 4, 5, 11-19, 21-28, 30-34 and 36-40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Liechti et al. (5,715,164) in view of Williams et al (U.S. Pat. No. 4,517,410).

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As per claims 1, 3, 4, 5, 12-14, 17, and 24-26 Liechti substantially discloses a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines to conduct telemeter setting transactions (which is equivalent to Applicant's claimed invention wherein said a method of metering digital content having a message to be presented to a plurality of users of a communications network), comprising: embedding a code in said message (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7); detecting the embedded code (see., abstract, col 1, lines 20-31); and based on the detected embedded code (see., abstract, col 1, lines 20-31, specifically wherein said verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein said the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, col 5, lines 23-65). It is to be noted that Liechti fails to explicitly disclose wherein said counting the number of times the message is presented to a user of the communications network. However, Lee discloses a counter means associated with said monitoring means of said controller for counting the number of times each one of a plurality of said message identifiers is entered by the user indicating the number of times each message is requested to be played back to the user, and means for storing

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an accumulated count after each message is played back for permitting an operator to read out the accumulated counts (see., abstract, col 13, lines 25-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the postage meter of Liechti by including the limitation detailed above as taught by Williams because this would detect and count message data associate with each user (s).

As per claims 2, 16, and 19 Liechti discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

As per claims 11, 15, 18, 21, and 23, Liechti discloses the claimed method wherein the digital content is indicative of an advertisement (see., col 10, lines 1-5, specifically wherein it is stated that computer 103 may utilize the hardware information for advertisement).

As per claims 22, 27 and 30-34, 36-40 Liechti substantially discloses a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines

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to conduct telemeter setting transactions (which is equivalent to Applicant's claimed invention wherein it is stated that a method of metering digital content having being presented to users of a communication network, the digital content being contained in a network data stream and including a message embedded with a code to allow a number times the message is presented to a user to be counted see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65, comprising:

monitoring the network data stream to detect data representative of the embedded code (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7);

recording a number of times the data representative of the embedded code is detected, the number of times the data representative of the embedded code is detected being indicative of presentation of the message to a user (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host

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computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65); and

calculating a charge (or charge class) for presenting the message based on the computer of times the data representative of the embedded code is detected (see., abstract, col 1, lines 20-31, col 2, lines 14-27, col 4, lines 50-60, specifically wherein it is stated that charge class 1 includes items with a postage value of 29 cents, charge class 2 includes items with postage values between 30 cents and 35 cents, please note that charge classes i.e class 1 and class 2 are interpreted as a process of calculating a charge).

It is to be noted that Liechti fails to explicitly disclose wherein said counting the number of times the message is presented to a user of the communications network. However, Lee discloses a counter means associated with said monitoring means of said controller for counting the number of times each one of a plurality of said message identifiers is entered by the user indicating the number of times each message is requested to be played back to the user, and means for storing an accumulated count after each message is played back for permitting an operator to read out the accumulated counts (see., abstract, col 13, lines 25-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the postage meter of Liechti by including the limitation

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detailed above as taught by Williams because this would detect and count message data associate with each user (s).

As per claim 28, Liechti discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent examiner

October 25, 2004